

REMARKS

1) Summary of Office Action

Claims 36 to 55 are currently pending in this application. In the Office Action of May 4, 2006, all of claims 36 to 55 were rejected under 35 U.S.C. 103(a) as being obvious in view of various combinations of references, as follows:

(a) Claims 36 to 39, 41 and 42 are rejected as being obvious given US 4,796,758 of Hauk in light of US 5,090,526 of Jacober (No.1).

(b) Claim 40 stands rejected in view of Hauk and Jacober (No. 1), further in view of Young.

(c) Claims 43 – 46 and 48 – 55 stand rejected given US 5,865,314 of Jacober (No. 2) in light of Jacober (No. 1).

(d) Claim 47 stands rejected in view of Jacober (No. 2) and US 6,092,661 of the Mogil.

2) Comments on Rejections Under 35 USC 112

Claim 42

An amendment has been made to claim 36 so reverse the “upper” and “lower” chambers, such that claim 42 does not require amendment.

Claim 55

Claim 55 has been amended as suggested by the Examiner.

3) Commentary on Rejections under 35 USC 103 – Underlying Law

The Applicant respectfully traverses all of the present rejections, and requests their reconsideration and withdrawal. Notwithstanding the amendments made herein, the Applicant reserves its right to pursue any or all of the present claims as they stood

prior to amendment by way of division or continuation at such time as may be appropriate. The Applicant explicitly does not intend by these amendments to surrender any scope under the doctrine of equivalents either with respect to the claims as they formerly stood, or with respect to the claim scope to which the Applicant would have been entitled had the claims been originally submitted in the manner in which they stand as amended.

(a) MPEP Section 2142: Basic Requirements of a *Prima Facie* Case of Obviousness

First, while the Office Action recites the criteria of *Graham v. John Deere Co.*, it omits to mention the procedure set out in MPEP 2142, and the long line of case law supporting the test for establishing *prima facie* grounds of rejection under 35 USC 103(a).

Section 2142 of the Manual of Patent Examining Procedure (MPEP) states:

ESTABLISHING A *PRIMA FACIE* CASE OF OBVIOUSNESS

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant’s disclosure. *In re Vaeck*, 947 F. 2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

(b) Mere Possibility of Combination is Not Sufficient

Section 2143.01 of the Manual of Patent Examining Procedure (MPEP) states:

FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)

(c) Must Have Teaching, Suggestion, or Incentive to Combine

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention *absent some teaching, suggestion or incentive* supporting the combination *ACS Hospital Systems Inc. v. Montefiore Hospital*, 732 F. 2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir., 1984.). Cited in *In re Geiger*, 815 F.2d at 688, 2 U.S.P.Q.2d at 1268 (Fed. Cir. 1987) (Emphasis added). See also *In re Lee*, (61 U.S.P.Q. 2d 1430, 277 F.3d 1338 (CAFC, 2002)).

Obviousness cannot be established by combining references without also providing objective evidence of the motivating force that would impel one skilled in the art to do what the patent applicant has done (See *In Re Lee*, *infra*; see also *Ex Parte Levengood*, 28 U.S.P.Q.2d 1300, 1302 (Bd. Pat. App. & Inter. 1993)).

(d) Inquiry Must Present a Convincing Line of Reasoning

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed toward obvious subject matter, either the references must expressly or impliedly, suggest the claimed invention or *the examiner must present a convincing line of reasoning* as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex Parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985) (Emphasis added).

When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex Parte Skinner*, 2 U.S.P.Q.2d 1788 (Bd. Pat. App. & Inter. 1986)."

(e) Inquiry Must Be Thorough And Searching

"The factual enquiry whether to combine the references must be thorough and searching. *Id.*, It must be based on objective evidence of

record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. ...

"The need for specificity pervades this authority. See e.g.,

"In re Kotzab 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.");

In re Rouffet, 149 F.3d 1350, 1359, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.");

In re Fritch, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992) (The examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

(*In re Lee*, 61 U.S.P.Q.2d 1430, 277 F.3d 1338, (CAFC, 2002). Emphasis and paragraph division added.)

Conclusory statements by an examiner do not adequately address the issue of motivation to combine. (*In re Lee, supra*).

(f) "Would have been obvious to one skilled in the art"

The MPEP requires that the examiner provide an objective source of support for a contention that a feature is known or obvious to one skilled in the art. An unsupported statement that a feature or combination "would have been obvious to one skilled in the art" is improper if made without support. *In re Lee, supra*, and *In re Garrett* 132 U.S.P.Q. 514 (Pat. Off. Bd. App. 1961).

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the

claimed invention was made because references relied upon teach that all aspects of the claimed invention were individually known in the art” is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). See also *Al-site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide suggestion to combine references).

4) Commentary on References and Claim Amendments

There is no indication that the Hauk reference concerns a not a soft-sided insulated container. Hauk explicitly refers to the lower portion as an “insulated chest”. (See, Hauk, Abstract, col. 3, lines 43 – 56, 60; col. 4, lines 4 and 19). Hauk also indicates that “The interior and exterior corners of the chest 24 are rounded, so as to provide maximum exposed surface area for the chilling of expressed human milk and so as to press and conform the chilling means to the storage bottles.” (Col. 3, lines 50 – 54). (Emphasis added.)

This description appears inconsistent with the contention that the Hauk apparatus is a soft-sided insulated container. The term “insulated chest”, and the stiffness implied in the phrase “... to press and conform the chilling means...”, appear to indicate that the object is substantially rigid, not soft-sided. The claims have been amended to repeat the soft-sided insulated nature of the container, which had been indicated in the preamble, in the body of the claims as well.

Clearly the Hauk reference also lacks the downwardly concave profile set out in the claims.

Neither of the Jacober references has the attributes set out in the claims. The '314 reference has neither the upstanding sidewalls recited, nor the downwardly concave profile. The '526 Jacober reference is a single chamber bag with a fixed internal shelf. Instant claims 36 and 43 have been amended to clarify that when the closure member of the lower portion is open, the panel that segregates the upper and lower portions is movable relative to the lower portion. Jacober '526 does not have an upper portion, or a panel, that is movable relative to the lower portion when the closure member of the lower portion is in an open condition.

Given that Jacober's drawings are not overly consistent or definitive, and given the lack of commentary in Jacober '526 on the point, the Applicant takes no position at this time as to whether the end wall profile of Jacober '526, can fairly be characterised as being "downwardly concave". The Applicant explicitly reserves its right to submit argument on this point (or not) at such time as may be appropriate.

Notwithstanding the evident diligence with which the Office Action has been prepared, there is nothing in the Office Action, or in the cited references, that identifies a Figure and item number, or a column and line number at which there is any motivation, suggestion, or incentive to modify the references as proposed in the Office Action. Rather, the Office Action makes an impermissible hindsight analysis employing the Applicant's claims as a road map by which features are plucked from the secondary references to "fill in the blanks" of the recited features that are missing from the primary references. It is precisely this kind of hindsight mosaic construction that the law seeks to prohibit by requiring that there be a separate and identifiable indication of motivation,

suggestion, or incentive to modify or combine identified in the objective art of record. This has been reinforced in a long line of cases such as *Kotzab*, *Rouffet*, *Fritch* and *Lee*, all cited above.

The applicant respectfully submits that there is no motivation, suggestion or incentive demonstrated in the objective art of record in this case to convert Hauk to a soft sided insulated container, or to employ downwardly concave end walls, or to provide a panel that moves with the upper portion of the assembly.

Similarly, there is nothing in the Office Action that indicates where there is, in the objective art of record in this case anything to urge that the bag of Jacober '526 be combined in whole or in part with either of the Hauk or Jacober '314 references, in any manner whatsoever, let alone in a manner yielding the subject matter of the claims herein.

For these reasons, and in view of the present amendments, the Applicant respectfully submits that claims 36 – 55 are presently allowable. The Applicant respectfully requests that the current rejections be withdrawn, and that the case be passed to allowance.

Respectfully submitted,


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